



Atty. Docket No. OLI02 P-350

3704 3724
#112/10
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Ret re
Restriction

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October 15, 2002
Date

Melanie S. Jernberg
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 3724
Applicant : Perry R. DeYoung
Appln. No. : 09/586,943
Filing Date : June 2, 2000
Confirmation No. : 6561
For : AUTOMATIC COVER LATCH AND PRESSURE
RELIEF SYSTEM FOR A FOOD PRESS

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Assistant Commissioner for Patents
Attn: Director of Group 3700
Washington, D.C. 20231

Dear Sir:

PETITION UNDER 37 C.F.R. §1.144

Applicant hereby petitions the Commissioner to withdraw the restriction requirement made in the July 16, 2002 Office Action for the above-identified patent application. Applicant respectfully submits that the restriction requirement as set forth in the Office Action is improper and should be withdrawn.

As explained below, the Examiner has imposed a seven-way restriction requirement on the claims. Those claims included 62 total claims and 6 independent claims. Specifically, the Examiner has restricted the claims as follows:

Group I - claims 2 and 40, drawn to a food press with a delay device,

Group II - claims 3-6, 14-17, 19-22, 31-34, 41-44, 46-49 and 51-54, drawn to a food press with a specific press plate configuration;

Group III - claims 7, 8, 23 and 24, drawn to a food press with a combination specific press plate configuration and a knife assembly;

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Group IV – claims 10-13 and 27-30, drawn to a food press with a knife assembly;

Group V - claims 9, 25, 26, 45, 55 and 56, drawn to a food press with a specific lid configuration;

Group VI - claim 35, drawn to a food press with a combination specific press plate configuration and a delay device; and

Group VII - claims 36-38, drawn to a food press with a combination specific press plate configuration and a specific lid configuration.

Claims 1, 18, 39, 50, 61 and 62, which are the only independent claims in the current application, are included in all of the groups. Applicant submits that all of these independent claims are therefore generic. See M.P.E.P. §§806.04(d) and 806.04(e).

Applicant elected Group II of the claims with traverse in a response filed March 28, 2002.

According to the Office Action mailed February 28, 2002, the claims of Groups II, III and IV are related as combination-subcombination and the following claims are related as subcombinations usable together:

1. Group I and Groups II-V and VIII;
2. Group II and Groups IV and V;
3. Group VII and Groups V-VII;
4. Group IV and Groups V-VII;
5. Group V and Group VI; and
6. Group VI and Group VII.

2. Legal Standards

MPEP § 806.05 states:

Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are not distinct, restriction may be proper. If they are ^{not} distinct, restriction is never proper.

argued

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MPEP § 806.05(a) states:

A combination is an organization of which a subcombination or element is a part.

Thus, a combination claim may, for example, include elements A, B, and C, whereas the subcombination by definition could only include A and B, A and C, or B and C. The subcombination clearly could not include all the elements of the combination.

Regarding the criteria for subcombinations usable together, MPEP §806.05(d) states "[t]wo or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other." "Care should always be exercised in this situation to determine if the several subcombinations are generically claimed." See MPEP § 806.04(b).

Where subcombinations as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP § 806.04(b)).

The practice applicable to election of species is set forth in MPEP § 806.04(f), which states:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while the second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

Thus, for two claims characterized as subcombinations that both depend from the same independent and generic claim, the claims must be distinct under the criteria applicable to subcombinations having separate utility and the claims must define mutually exclusive characteristics.

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3. Arguments

Based upon the above legal standards, Applicant submits that the restriction requirement made by the Examiner is improper for the reasons stated below.

Regarding the restriction for the inventions as being related as combination and subcombination, the Examiner has stated that the inventions of Group III and Groups II and IV are distinct if there is evidence that the combination does not rely on the subcombination for patentability and that Group IV is evidence that the combination of Group III does not rely on the specific press plate configuration of Group II for patentability and Group II is evidence that the combination of Group III does not rely on the knife assembly of Group IV for patentability. Paragraph 5 of Office Action mailed February 28, 2002. The Examiner goes on to state that Group II is evidence that the combination of Group VI does not rely on the delay device of Group I for patentability and Group I is evidence that the combination of Group VI does not rely on the press plate configuration of Group II for patentability. Finally, the Examiner states that the invention of Group II is evidence that the combination of Group III does not rely on the specific lid configuration of Group V for patentability and Group V is evidence that the combination of Group III does not rely on the specific press plate configuration of Group II for patentability. However, claims 1, 18, 39, 50, 61 and 62 are included in all of the groups. Therefore, since the independent claims are in all of the groups, the independent claims define the patentability. For example, Applicant submits that claim 1 of Group IV is not evidence that claim 1 of Group III does not rely on the specific press plate configuration of Group II for patentability. The remaining combinations and subcombination restrictions can be analyzed in the same manner. Notably, all of the independent claims in this application belong to each of the groups and since claims are assumed to be in proper form and patentable over the prior art, Applicant submits that the features of the dependent claims in the groups are not required for patentability. See M.P.E.P. §608.02. Notably, in the last Office Action on the merits, none of the claims were rejected over the prior art. Accordingly, Applicant submits that the combination/subcombination restriction was improper and should be withdrawn.

Regarding the restriction for subcombinations usable together, distinct claims each claiming subcombinations usable together that contain species under a genus (or generic) claim

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must have the question of restriction determined by both the practice applicable to election of species and the practice applicable to related inventions. The inventions of Groups I, II, III, IV, V, VI and VII include dependent claims that are all dependent on independent claim 1, and as such, the subcombinations are claimed under a common genus claim. Specifically, claim 1 is a generic claim. Notably, the Examiner has stated that claims 1 and 18 recite "subject matter that is common to all of the groups." Paragraph 3 of the Office Action mailed February 28, 2002. In other words, claim 1 reads upon all of the claims that depend from claim 1. Moreover, the Examiner has indicated that all of the claims, except for claims 1, 18, 39, 50, 61 and 62, are claims drawn to a subcombination.

An independent claim cannot be considered a combination relative to a "subcombination" claim that depends from that independent claim. A subcombination by definition includes less than all of the elements of the combination. A dependent claim clearly cannot include less than all of the elements of the claim(s) on which it depends. Accordingly, for example, claim 2 (Group I), claim 3 (Group II), claim 7 (Group III), claim 10 (Group IV), claim 9 (Group V), claim 35 (Group VI) and claim 36 (Group VII) are all combination claims with claim 1 being the subcombination claim of each of these claims. Therefore, claim 1 is readable on all of its dependant claims and is therefore generic to all of the claims that depend upon claim 1. Clearly, the dependent claims in the groups include all the elements of claim 1, from which claims 2-17, 35 and 36 depend. Therefore, claims 2-17, 35 and 36 are all species disclosed under a claimed genus and related. Accordingly, the requirements for election of species must also be applied. Such an analysis was not made by the Examiner.

Nevertheless, claimed elements of different groups as defined by the Examiner may be usable together. Therefore, such components are not mutually exclusive of one another. For an election of species requirement to be proper, the two claimed species must be mutually exclusive of one another and may not be used together in the combination. Because the Examiner has failed to apply the criteria for election of species and because the criteria would not apply in this instance, Applicant submits that the restriction requirement between the groups is improper.

No species
restriction
was made.

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Furthermore, claimed subcombinations must be disclosed as usable together in a single combination. "Two or more claim subcombinations, disclosed as useful together in a single combination, and which can be shown to be separately usable, are usually distinct from each other." M.P.E.P. § 806.05(b). Groups I, II, III, IV, V, VI and VII are not subcombinations that are disclosed as usable together in a single combination. As an example, claims 2 (Group I), 3 (Group II), 7 (Group III), 10 (Group V), 9 (Group IV), 35 (Group VI) and 36 (Group VII) are claims that do not define subcombinations disclosed as usable together in a single combination. Claims 3, 7, 9, 10, 35 and 36 are all dependent claims. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference and to the dependent claim." 37 C.F.R. § 1.75(c).

If claims 2, 3, 7, 9, 10, 35 and 36 each define a subcombination as stated by the Examiner, the subcombinations combined together in a single combination would include at least seven identical hoppers, seven identical latch assemblies and seven identical press plates. However, no such combination is disclosed in the present application. Therefore, the claims in Groups I, II, III, IV, V, VI and VII are not subcombinations that should have been subject to a restriction requirement. The remaining claims made subject to the restriction requirement can be analyzed as discussed above.

Upon reviewing the Examiner's statements as to why the claims are restricted, it is apparent that the Examiner may be considering dependent claims as though they were independent claims. Applicant submits that the restriction requirement as presented is clearly erroneous and therefore submits that the restriction requirement regarding subcombinations usable together should be withdrawn. Therefore, the claims identified in Groups I, III, IV, V, VI and VII should be examined with the election of Group II. Accordingly, Applicant submits that all claims should be examined along with the election of Group II.

For the reasons stated above, Applicant submits that the restriction requirement should be withdrawn, and therefore requests such action. The petition fee of \$130 is enclosed. If any additional fees are required, Applicant requests that they be charged to Deposit Account No. 16 2463.

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Respectfully submitted,

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10/15/02
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MPD/msj

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